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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,409

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EXAMINER

COMSTOCK, NATHAN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/07/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,409	<b>Applicant(s)</b> SUGA ET AL.	
	<b>Examiner</b> NATHAN E. COMSTOCK	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 6-8 is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on 11 September 2009 is acknowledged. Claims 1-3 and 5-12 are pending. Claims 1 and 5-12 have been amended. Claim 4 has been cancelled. Claims 9-12 stand withdrawn.

### *Election/Restrictions*

2. Claims 1-3 and 6-8 are allowable. The restriction requirement, as set forth in the Office action mailed on 08 July 2009, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 9-12, directed to an injection-mold decorating method, are withdrawn from further consideration because they do not require all the limitations of an allowable generic linking claim as required by 37 CFR 1.141. Specifically, claims 9-12 do not require that the glossy layer be formed on the back surface of the transparent resin substrate sheet.

3. For Applicant's convenience, notation of hypothetical objections and rejections to currently withdrawn claims 9-12 have been included herein so that they may be addressed prior to rejoinder should rejoinder become proper.

4. In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of

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35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

***Claim Objections***

5. Should rejoinder become proper, Claim 9 will be objected to because of the following informalities: in line 7, there is an extra comma (,) after the word “has”, in line 17, the phrase “a resin is poured” should read “pouring a resin”, and in lines 17-18, the phrase “and is then hardened” should read “and hardening the resin”. Appropriate correction will be required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 5 recites that the transparent resin substrate sheet is composed of a first transparent resin substrate sheet on the front surface of the decorating sheet and a second transparent resin substrate sheet on the back surface of the decorating sheet. It is unclear how the second transparent resin substrate sheet can part of the transparent resin substrate sheet while being on the back surface of the decorating sheet, given that a glossy layer (which is also part of the decorating sheet) is on the back surface of the transparent resin substrate sheet. For purposes of examination, the second transparent resin substrate sheet will be construed to be the portion of the transparent resin substrate sheet adjacent the glossy layer.

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9. Should rejoinder become proper, claims 10-12 will be rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 10 recites the transparent substrate sheet has a first transparent resin substrate sheet on the front surface and a second transparent resin substrate sheet on the back surface. It is unclear whether the first and second transparent resin substrate sheets comprise the transparent resin substrate sheet, or are separate layers that are laminated to the front and back surfaces of the transparent resin substrate sheet, respectively. Claims 11 and 12 will be rejected at least for the reasons of claim 10.

***Allowable Subject Matter***

11. Claims 1-3 and 6-8 are allowed.

12. Claim 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

13. The following is a statement of reasons for the indication of allowable subject matter: the considered prior art does not disclose or suggest a transparent resin substrate sheet having a glossy layer formed on the back thereof, wherein the front surface of the substrate sheet is divided into high and low gloss regions, wherein the substrate sheet is thicker at the high gloss regions and thinner at the low gloss regions, wherein the back surface of the substrate sheet and decorating sheet have protrusions protruding toward the back surface direction in register with the high gloss regions.

***Response to Arguments***

14. Applicant's arguments in the Response filed 11 September 2009 with respect to the rejection as anticipated and/or obvious of claims 1-8 have been fully considered and are persuasive. The rejections of claims 1-3 and 5-8 have been withdrawn.

15. With respect to Applicant's request for rejoinder of withdrawn process claims, process claims will not be rejoined where the process claims do not require all of the limitations of the allowable product claim. See MPEP 821.04. This applies to both U.S. restriction practice and to lack of Unity practice under the PCT. See MPEP 1893.03(d). As noted previously, claims 9-12 do not require all of the limitations of the allowable product claim, because they do not require that the glossy layer be formed on the back surface of the transparent resin substrate sheet. Therefore, rejoinder is improper at this time.

***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN E. COMSTOCK whose telephone number is (571) 270-1133. The examiner can normally be reached on Monday through Thursday, 9am-6pm Eastern Standard Time.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1794

/N.E.C./  
Nathan E. Comstock  
Patent Examiner, Art Unit 1794  
31 December 2009